

Application No.: 10/072,421

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Docket No.: 426882005100

REMARKS

Claims 1-46 are pending in the instant application. Claims 1-46 are rejected.

Rejection Under 35 U.S.C. §103(a):

The Examiner has maintained the rejections under 35 U.S.C. § 103(a) over U.S. Patent No. 5,675,746 Marshall, in view of U.S. Patent No. 5,977,974 to Hartori et al. Applicant again respectfully traverses the rejections.

Basically, while Applicant agrees that Marshall discloses a desire to provide a "virtual reality user" with a visual representation generally, Applicant disagrees that, under the standards adopted by the Federal Circuit, it is proper to parlay this general desire into a suggestion to modify Marshall in view of the particular disclosure of Hartori.

In the previous response filed by Applicant, Applicant argued that the Examiner has essentially restated the improperly-alleged "design choice" motivation. While the Examiner has ostensibly devoted much of the present Office Action text to a section entitled "Response to Arguments," the Examiner has notably not addressed Applicant's arguments with respect to design choice.

It should be noted that Applicant agrees with the Examiner's assertion that the combination of disclosure should be taken as a whole to see what would be suggested to one of ordinary skill in the art. However, Applicant disagrees with the assertion that disclosures taken as a whole would suggest incorporating the *particular* visual representation disclosed by Hartori into the virtual reality representation disclosed by Marshall. That is, the Examiner's citation of an expression in Marshall of a general desire to provide a "visual representation" does not satisfy the requirements of a *prima facie* case of obviousness. Similar to the "design choice" allegations made by the Examiner in the first Office Action, the expression in the art of the general desire for a "visual representation" suggests to one of ordinary skill in the art that, at best, there are a broad range of possibilities of visual representations-- of which the representation disclosed by Hartori is but one.

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To allege that the stated general desire *prima facie* suggests using a particular one of the broad range of possibilities is to use an "obvious to try" test of obviousness that has been steadfastly rejected by the Federal Circuit.

The Examiner is referred, for example, to the Federal Circuit's decision in *In re O'Farrell*, 853 F.2d 894, 903, 7 U.S.P.Q.2D (BNA) 1673, 1681 (Fed.Cir. 1988) (citations omitted), where the court states:

The admonition that "obvious to try" is not the standard under § 103 has been directed mainly at two kinds of error. In some cases, what would have been "obvious to try" would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful. In others, what was "obvious to try" was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it.

In the present situation, at least the first kind of error is present. That is, as discussed above, in so many words, the Examiner is suggesting that it would have been "obvious to try" each of numerous possible choices of "visual representation" in a virtual reality system, including the visual representation allegedly disclosed by Hartori, and that this would satisfy the standard under § 103. In this case, though, where the prior art gives no indication of which parameters are critical or which of the many possible choices is likely to be successful, it is an error to apply this reasoning to make an obviousness rejection.

Along those lines, it is notable that the Examiner has not addressed Applicant's contention that Hartori, in fact, teaches away from making the proposed combination. Briefly, Applicant's contention (set forth in the previous response) was that Hartori disclose that the motivation for arranging data icons in time order is to assist in searching for particular data items, and this does not suggest that employing the disclosed data icon arrangement would solve a problem or disadvantage with the Marshall system or otherwise solve a problem with the Marshall arrangement of "stock metaphors."

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Furthermore, Applicant has pointed out in the previous response how in some instances, the combination of Marshall and Hartori, even if such a combination could be properly made, does not yield what is claimed. Applicant pointed out that, for example, neither Marshall, Hartori, nor the combination, recites linear display portions corresponding to separate time segments. The Examiner has not responded to these contentions of Applicant. Various other examples were provided, where Applicant pointed out how the references, alone or in combination, do not yield what is claimed. For example, with respect to the dependent claims, in many instances, the Examiner merely referenced "see explanation on claim 1." It is axiomatic that each claim stands on its own and that, therefore, the explanation with regard to rejecting claim 1 does not suffice to explain a rejection of the claims dependent thereon. In this specific instance, the dependent claims recite features not addressed in the "explanation on claim 1." The Examiner is specifically referred to page 4 of the previous response. If the Examiner continues to reject the claims, then Applicant respectfully requests the Examiner to point out where the references are alleged to disclose the features recited in the claims.

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CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket No. 426882005100. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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